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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,204	10/16/2001	Takashi Hayashihara	1630.1002	3598
21171	7590	12/01/2003	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			LUONG, VINH	
			ART UNIT	PAPER NUMBER
			3682	

DATE MAILED: 12/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/977,204

Applicant(s)

HAYASHIHARA, TAKASHI

Examiner

Vinh T Luong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

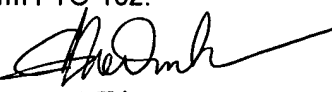
- 4) ☒ Claim(s) 1,2,4-10 and 12 is/are pending in the application.
- 4a) Of the above claim(s) 6-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,10 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.


Vinh T. Luong
Primary Examiner

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *Exhibit*.

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the previous Office action on May 19, 2003 has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 13, 2003 (Paper No. 9) has been entered.

2. The restriction and the election in the parent application are carried over to the instant request for continued examination (RCE). Claims 6-9 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 5.

3. The proposed substitute sheet of drawings, filed on August 13, 2003 has been approved.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. Claims 1, 2, 4, 5, 10, and 12 rejected under 35 U.S.C. 103(a) as being unpatentable over Toelke et al. (US Patent No. 6,367,348 B1).

Regarding claim 1, Toelke's first embodiment of Figs. 1-8 and third embodiment of Figs. 10-12 teach a pedal device mounted on a bracket 20 (Fig. 3) fixed to a body of an automotive vehicle, and including a pedal arm 10 having an operating portion 16 at a lower end thereof, and a position adjusting device operable to adjust a position of said operating portion 16 in a longitudinal direction of the automotive vehicle where said pedal arm 10 is placed in a nonoperated state thereof, said position adjusting device comprising:

a first member 12 (Fig. 2 on page 1 of Exhibit attached) having a pair of guides 28 and 30;

a second member 14 disposed movably relative to said first member 12 in an approximately vertical plane approximately parallel to said longitudinal direction, and having a pair of guide pieces 36, 38 which are movable in engagement with said pair of guides 28 and 30, respectively; and

a positioning device operable to establish a desired relative position between said first and second members 12 and 14, by moving said pair of guides 28 and 30 and said pair of guide pieces 36, 38 relative to each other, said positioning device permitting said first second members 12 and 14 to maintain said desired relative position after said desired relative position is established,

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wherein one (14) of said first and second members 12 and 14 has said operating portion 16 and is movable relative to the other (12) of said first and second members 12 and 14, to move said operating portion 16 in said longitudinal direction,

and wherein said pair of guides 28 and 30 consist of a pair of straight guides 28 and 30 which are formed and positioned such that the extension lines EXT. 1 and EXT. 2 of said straight guides 28 and 30 parallel to each other (page 1 of Exhibit).

In summary, Toelke's first and third embodiments teach substantially applicant's claimed invention except that the extension lines EXT. 1 and EXT. 2 of the guides 28 and 30 are parallel instead of intersecting each other. However, Toelke teaches or expressly suggests in line 55 *et seq.*, column 12 that the guides in the first and third embodiments can be inclined like the second, fourth, and fifth embodiments (Fig. 9, Figs. 13-15, and Figs. 16-18 respectively). When one changes the orientation of the Toelke's guides in Toelke's first and third embodiments to become inclined like Toelke's guides in Toelke's fourth and fifth embodiments, the guides 28 and 30 of Toelke's first and third embodiments become inclined in the same manner as shown in Toelke's Fig. 14 or applicant's Figs. 1 and 2. Consequently, the extension lines EXT. 1 and EXT. 2 of Toelke's pair of guides 28 and 30 in the first and third embodiments become intersecting with each other (see page 2 of Exhibit) such that a vertical position of said operating portion 16 is inherently lowered as said operating portion 16 is moved toward the rear of the vehicle parallel to said longitudinal direction as best seen or visualized by Toelke's Fig. 14 (page 3 of Exhibit).

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to incline the guides of Toelke's first and third embodiments as expressly taught or suggested by Toelke's fourth and fifth embodiments in order that the extension lines of the guides of the first and third embodiments intersect each other to move the operating portion toward the rear of the vehicle parallel to the longitudinal direction of the vehicle when the driver desires to adjust the position of the pedal.

Regarding claim 2, said pair of straight guides 28 and 30 which are positioned such that extension lines EXT. 1 and EXT. 2 of said straight guides 28 and 30 intersect each other (page 2 of Exhibit) such that an attitude of said operating portion 16 changes and said vertical position of said operating portion 16 is lowered as said operating portion 16 is moved in said rearward direction in relation to the vehicle, parallel to said longitudinal direction as a result of a relative movement of said first and second members 12 and 14 with said pair of guide pieces 36 and 28 being moved in engagement with said pair of straight guides 28 and 30, respectively as visualized by Fig. 14 (page 3 of Exhibit).

Regarding claim 4, said second member 14 has said operating portion 16 and is movable relative to said first member 12 and said positioning device comprises a relative -movement device including a feedscrew 18, 84 (*id.*, line 37 *et seq.*, column 7) disposed on said first member 12 such that said feedscrew 18, 84 is parallel to one of said pair of straight guides 28 and 30 and rotatable about an axis thereof, and an internally threaded member 68 connected to one (38) of said guide pieces 36 and 38 which engages said one (30) of said pair of straight guides 28 and 30, said internally

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threaded member 68 being held in engagement with said feedscrew 84 and pivotable relative to said second member 14 about an axis perpendicular to said approximately vertical plane, and wherein said relative movement device is operable to rotate said feedscrew 84 to move said second member 14 relative to said first member 12 and maintain said desired relative position between said first and second members 12 and 14 after a rotary motion of said feedscrew 84 is terminated.

Regarding claim 5, said pedal arm 10 includes said first and second 12 and 14 members, and said other (12) of said first and second members 12 and 14 which does not have said operating portion 16 is a pivotal arm 12 which is disposed pivotally about a support shaft 22 (Fig. 3. *Ibid.*, line 46 *et seq.*, column 4) supported by said bracket 20, said pedal arm 12 being pivoted about said support shaft 22 when said pedal arm 12 is operated at said operating portion 16.

Regarding claim 10, wherein said pair of guides 28 and 30 are formed and positioned such that an operating surface (page 1 of Exhibit) of said operating portion 16 is gradually inclined while the vertical portion of said operating portion is lowered as said operating portion is moved toward the rear of the vehicle, parallel to said longitudinal direction due to the inclined slot 28 as visualized by Fig. 14 on page 3 of Exhibit.

Regarding claim 12, Toelke's first and third embodiments teach a pedal device mounted on a bracket 20 fixed to a body of an automotive vehicle, and including a pedal arm 10 having an operating portion 16 at a lower end thereof, and a position adjusting device operable to adjust a position of said operating portion 16 in a longitudinal direction of the automotive vehicle where said pedal arm 10 is placed in a non-operated state thereof, said position adjusting device comprising:

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a first member 12 (page 1 of Exhibit) having a pair of straight guides 28 and 30 which are positioned such that extension lines EXT. 1 and EXT. 2 of said straight guides 28 and 39 parallel to each other;

a second member 14 disposed movably relative to said first member 12 in a vertical plane parallel to said longitudinal direction, and having a pair of guide pieces 36 and 38 which are movable in engagement with said pair of guides 28 and 30 respectively; and

a positioning device operable to establish a desired relative position between said first and second members 12 and 14, by moving said pair of guides 28 and 30 and said pair of guide pieces 36 and 38 relative to each other, said positioning device permitting said first and second members 12 and 14 to maintain said desired relative position after said desired relative position is established,

wherein one (14) of said first and second members 12 and 14 has said operating portion 16 and is movable relative to the other (12) of said first and second members 12 and 14, to move said operating portion 16 in said longitudinal direction.

In summary, Toelke's first and third embodiments teach substantially applicant's claimed invention except that the extension lines EXT. 1 and EXT. 2 of the guides 28 and 30 are parallel instead of intersecting each other. However, Toelke teaches or expressly suggests in line 55 *et seq.*, column 12 that the guides in the first and third embodiments can be inclined like the second, fourth, and fifth embodiments (Fig. 9, Figs. 13-15, and Figs. 16-18 respectively). When one changes the orientation of the Toelke's guides in Toelke's first and third embodiments to become inclined like Toelke's guides in Toelke's fourth and fifth embodiments, the guides 28 and 30 of Toelke's first and

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third embodiments become inclined in the same manner as shown in Toelke's Fig. 14 or applicant's Figs. 1 and 2. Consequently, the extension lines EXT. 1 and EXT. 2 of Toelke's pair of guides 28 and 30 in the first and third embodiments become intersecting with each other (page 2 of Exhibit) such that a vertical position of said operating portion 16 is inherently lowered as said operating portion 16 is moved toward the rear of the vehicle parallel to said longitudinal direction as best seen in Toelke's Fig. 14 (page 3 of Exhibit).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incline the guides of Toelke's first and third embodiments as expressly taught or suggested by Toelke's fourth and fifth embodiments in order that the extension lines of the guides of the first and third embodiments intersect each other to move the operating portion toward the rear of the vehicle, parallel to said longitudinal direction when the driver desires to adjust the position of the pedal.

7. Applicant's arguments filed August 13, 2003 have been fully considered but they are not persuasive.

35 USC 112

The previous 35 USC 112 rejection is withdrawn in view of applicant's amendments.

ART REJECTION

The previous rejection under 35 USC 102(e) based on Sitrin or Toelke is withdrawn in view of applicant's amendments and replaced by the rejection under 35 USC 103 based on Toelke above.

Applicant alleges that:

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Thus, even if the inclined slots of the second, fourth, and fifth embodiments are combined with the pedal device of the first and third embodiments of Toelke, Toelke does not teach or suggest a pedal device whose operating portion moves downwardly, as claimed by the present invention. Moreover, Toelke also fails to teach or suggest any technical advantage provided by the downward movement of the operating portion, which is made possible by inclining the slots. The present invention, however, teaches that the operating portion of the pedal device can be easily operated, regardless of the height of the operator. For example, the inclined slots provide an advantage for drivers who have shorter legs and smaller feet, by allowing the operating portion of the pedal to be closer to the seat and closer to the floor of the vehicle. Thus, a shorter driver with smaller feet is not forced to use his or her tiptoe or lift his or her heel off the floor in order to depress the pedal. Instead, such a driver can apply force to the pedal with the area of the sole best suited for the application of such force. Accordingly, Applicant respectfully requests that the rejections of pending claims 1, 2, 4, 5, 10, and 12 be withdrawn.

Contrary to applicant's remarks, the examiner respectfully submits that:

(A) there is no combination of Toelke's second, fourth, and fifth embodiments with first and third embodiments of Toelke. The instant rejection is based on a mere change in the orientation of the guides of Toelke's first and third embodiments expressly suggested by Toelke; and

(B) Toelke does teach or suggest a pedal device whose operating portion moves downwardly, as claimed by the present invention and seen in, Fig. 14 (page 3 of Exhibit). Moreover, Toelke also teaches or suggests the technical advantage provided by the downward movement of the operating portion, which is made possible by inclining the slots (page 3 of Exhibit).

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Applicant apparently overlooks a well-established expectation that similar structures would behave similarly. *In re Merck & Co., Inc.*, 231 USPQ 375 (CAFC 1986). In the case *sub judice*, Toelke teaches the inclined guides substantially identical to applicant's guides. Therefore, Toelke's guides are expected to behave in the same manner as applicant's guides, *i.e.*, to move the operating portion gradually inclined upward while the operating portion 16 is moved toward the rear of the vehicle. The necessary inherence of Toelke's pedal is flown naturally from Toelke's teaching of the same type of applicant's inclined guides. *In re Best*, 195 USPQ 430, 433 (CCPA 1977) and MPEP 2112. On the other hand, the examiner respectfully submits that the Court has long laid applicant's arguments to rest by pointing out that when each element of a patent claim is found in one prior art reference, the patent claim is invalid. This is true, even if the intended use of the anticipating device is different from the intended use of the claimed device. *Mathis v. Hydro Air Industries*, 1 USPQ2d 1513, 1523 (DC C. Calif. 1986) and cases cited therein. Further, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In addition, note that the functional limitations of a claim may not be given patentable weight where those limitations are inherent in a prior art reference. *In re Schreiber*, 44 USPQ2d 1429 (CAFC 1997). Moreover, the examiner is mindful that applicant's claims are not process claims. Therefore, applicant's recitation with respect to the manner in which applicant's claimed apparatus is intended to be employed does

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not differentiate the claimed apparatus from the prior art apparatus if the prior art apparatus teaches all the structural limitations of the claims. *Ex parte Masham*, 2 USPQ2d 1647 (BPAI 1087) and MPEP 2114.

In the instant case, Toelke's invention teaches that the operating portion of the pedal device can be easily operated, regardless of the height of the operator in the same manner as applicant. Indeed, Toelke's inclined slots inherently provide an advantage for drivers who have shorter legs and smaller feet, by allowing the operating portion of the pedal to be closer to the seat and closer to the floor of the vehicle. Thus, a shorter driver with smaller feet is not forced to use his or her tiptoe or lift his or her heel off the floor in order to depress the pedal. Instead, such a driver can apply force to the pedal with the area of the sole best suited for the application of such force in the same manner as applicant's pedal. Notwithstanding this fact, assuming *arguendo* that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art Toelke, such advantage cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (BPAI 1985). Accordingly, the pending claims are maintained to be unpatentable.

8. Applicant's arguments with respect to claims 1, 2, 4, 5, 10, and 12 have been considered but are moot in view of the new ground(s) of rejection.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Luong whose telephone number is (703) 308-3221. The examiner can normally be reached on Monday-Thursday from 9:30 AM EST to 8:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci, can be reached on (703) 308-3668. The fax phone number for this Group is (703) 872-

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9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Luong

November 28, 2003

A handwritten signature in black ink, appearing to read 'Vinh T. Luong', with a long horizontal line extending to the right.

Vinh T. Luong
Primary Examiner